



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re the Application of:

Byung-in MA et al.

Serial No. 09/817,754

Confirmation No. 7872

Filed: March 27, 2001

Group-Art Unit: 2655

Examiner: Gautam Patel

For: APPARATUS FOR GENERATING SEEK DIRECTION DETECTING SIGNAL FOR
OPTICAL PICKUP

RECEIVED

SEP 23 2003

Technology Center 2600

RESPONSE TO RESTRICTION REQUIREMENTAssistant Commissioner for Patents
Washington, D.C. 20231

Sir:

This is responsive to the Office Action mailed August 19, 2003, having a shortened period for response set to expire on September 19, 2003, the following remarks are provided. The USPTO was officially closed on September 18 (Thursday) and 19 (Friday), 2003 due to Hurricane Isabel. Pursuant to 37 CFR 1.6(a)(1) and MPEP 510, these days are considered to be Federal Holidays within the District of Columbia. Thus, the enclosed papers are deemed timely filed on September 22, 2003.

I. Provisional Election of Claims Pursuant to 37 CFR §1.142

Applicants provisionally elect claims 1-18 in response to the preliminary restriction requirement set forth in the Office Action.

II. Applicants Traverse the Requirement

Insofar as Groups A (FIGS. 3-5), B (FIGS. 3, 4, and 5), D (FIG. 8), E (FIG. 9), and F (FIGS. 10 and 13) is concerned, it is respectfully noted that independent claim 1 covers the embodiments of these figures, thereby the evaluations of these groups would not provide an undue burden upon the Examiner at this time.

Further, it is believed that claim 38 is so closely related to elected claims 1-18 that they should remain in the same application. The elected claims 1-18 are directed to "a first signal

processing portion processing a track error signal from the signals output from the first optical detector; and a second signal processing portion processing a track cross signal from the signals output from the second optical detector; and a generator generating a seek direction detecting signal from the phase difference between the track cross signal and the track error signal,” and claim 38 is drawn to “processing a track error signal from the electrical signals obtained from the converted detected main beam; processing a track cross signal from the electrical signals obtained from the converted detected sub-beam; and generating a seek direction detecting signal from the phase difference between the track cross signal and the track error signal,” which are corresponding actions of the first signal processing portion, second signal processing portion, and generator, respectively. There have been no references cited to show any necessity for requiring restriction and, in fact, it is believed that the Examiner would find references containing both method and product claims in the same field of technology. It is believed, moreover, that evaluation of both sets of claims would not provide an undue burden upon the Examiner at this time in comparison with the additional expense and delay to Applicants in having to protect the additional subject matter recited by claim 38 by filing a divisional application.

Also, it is believed that claims 19-34 are so closely related to elected claims 1-18 that they should remain in the same application to preserve unity of the invention. The elected claims 1-18 are directed to “and a second optical detector receiving the sub-beam, . . . and a generator generating a seek direction detecting signal from the phase difference between the track cross signal and the track error signal,” and claims 19-34 are drawn to “a signal processing portion to process the first signals from the reflected main beam and to process the second signals from the reflected sub-beam; and a signal generating portion to generate a seek direction detecting signal using the processed first signals and the processed second signals,” where the actions of the signal generating portion correspond to the actions of the generator recited in independent claim 1. Further, the actions recited in independent claim 35 are corresponding actions of the a light dividing unit, a signal processing portion, and a signal generating portion, respectively, of independent claim 19.

MPEP §803 sets forth the criteria for restriction between patentably distinct inventions. (A) indicates that the inventions must be independent (see MPEP §802.01, §806.04, §808.01) or distinct as claimed (see MPEP §806.05-806.05(i)); and (B) indicates that there must be a serious burden on the Examiner if restriction is required (see MPEP §803.02, §806.04(a)- §806.04(i), §808.01(a) and §808.02). The Examiner has not set forth why there would be a serious burden

if restriction is required.

Even if the Examiner considers claims 1-18 to be a separate invention from claims 19-35, the Applicants respectfully request the Examiner to consider claims 1-18 and 38 together.

III. Conclusion

Upon review of references involved in this field of technology, when considering that the apparatus recited by claims 1-18 is directed to Groups A (FIGS. 3-5), B (FIGS. 3, 4, and 5), D (FIG. 8), E (FIG. 9), and F (FIGS. 10 and 13), and elected claim 38 is directed to Groups A (FIGS. 3-5), B (FIGS. 3, 4, and 5), D (FIG. 8), E (FIG. 9), and F (FIGS. 10 and 13), and when all of the other various facts are taken into consideration, it is believed that upon reconsideration of the Examiner's initial restriction requirement, claims 1-38 should be examined in the subject application.

In view of the foregoing amendments, arguments and remarks, all claims are deemed to be allowable and this application is believed to be in condition for allowance.


If any further fees are required in connection with the filing of this Amendment, please charge the same to our deposit account number 19-3935.

Should any questions remain unresolved, the Examiner is requested to telephone Applicants' attorney.

Respectfully submitted,

STAAS & HALSEY LLP

Date: September 22, 2003

By: 
Alicia M. Choi
Registration No. 46,621

700 11th Street, N.W., Ste. 500
Washington, D.C. 20001
(202) 434-1500